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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,850	07/03/2003	John W. Robinson	BFGRP0313USB	6883
53428	7590	09/01/2006		
DON W. BULSON (GOODRICH) RENNER, OTTO, BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE 19TH FLOOR CLEVELAND, OH 44115			EXAMINER SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 09/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/612,850

Applicant(s)

ROBINSON ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-9, 11 and 13-29 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 13-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

This is responsive to the Request for Continued Examination filed July 24, 2006 wherein the amendment after Final rejection filed July 10, 2006 which was denied entry in the advisory action mailed July 10, 2006 is now entered.

Claims 13-15 and 17-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Claims 7 and 16 are withdrawn as being directed to non-elected species. Applicant timely traversed the restriction requirement in the reply filed on August 8, 2005.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 8, 9 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

1. There is no support for the carboxyl-terminated butadiene-acrylonitrile copolymer limited to a "liquid at ambient temperature" since page 17, lines 8-10 describes the blending of the components at ambient temperature without indicating the phase of the blend. There is no description of the individual copolymer as being liquid at ambient temperature.

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More favorable consideration would be given to the replacement of the phrase with the Brookfield viscosity of from about 500 cps to about 2,500,000 cps at 25°C set forth on page 9, lines 16-17 and defined in claim 8.

Claims 1-3, 8, 9 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

2. The rejection based on the inconsistency of including monoepoxides such as octadecyleneoxide, epichlorohydrin, styrene oxide, vinylcyclohexene oxide and glycidyl methacrylate listed on page 6, line 30 to page 7, line 1 within the claimed epoxy resin requiring at least two epoxy groups per molecule necessary to participate in curing is maintained. The reasons for the inconsistency are explained in the non-Final rejection mailed January 18, 2006 (page 2, paragraph 1), the Final rejection and the advisory action (paragraph 2).

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Claims 10-3, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minamisawa et al. Patent No. 4,500,660 and Japanese Patent No. 64- 01-060679.

3. The rejection is maintained for the reasons of record set forth in the previous Office actions. No new arguments have been presented. Neither Minamisawa et al. nor the Japanese patent confine their carboxy-terminated butadiene-acrylonitrile copolymers any particular phase. It would have been obvious to formulate the compositions of Minamisawa et al. and the Japanese patent with the carboxy-terminated butadiene-acrylonitrile as a liquid at room temperature in order to facilitate the blending of the components.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers  
Primary Examiner  
Art Unit 1712